

## REMARKS

The present application was filed on June 8, 2000 with claims 1-25.

In the Office Action, the Examiner rejected claims 13-24 under 35 U.S.C. §112, first paragraph, as allegedly comprising “single means” claims, rejected claims 1, 3-6, 8-10, 13, 15-18, 20-22 and 25 under 35 U.S.C. §102(b), rejected claims 2, 7, 14 and 19 under 35 U.S.C. §103(a), and indicated that claims 11 and 23 contain allowable subject matter.

Applicant respectfully requests reconsideration of the present application in view of the above amendments and the remarks below.

With regard to the §112 rejection, the Examiner argues that independent claim 13, by virtue of the recitation of a single element in the form of “a signal processing device,” is a single element means claim. Applicant respectfully disagrees. The sixth paragraph of §112, with emphasis supplied, specifies that “[a]n element in a claim for a combination may be expressed as a means . . . for performing a specified function . . . .” Applicant submits that the fact the claim at issue does not use the specific word “means” coupled with the fact that this claim is not a claim for a combination makes it clear that the claim is not a single element means claim. Applicant recognizes that there is abundant case law dealing with claims for combinations which are interpreted as being means claims despite the fact that the specific word “means” is not used. See, e.g., Mas-Hamilton Group v. LaGard, Inc., 48 USPQ2d 1010 (Fed. Cir. 1998). However, Applicant emphasizes that this case law deals with claims for combinations of elements, and submits that it is largely inapplicable to claims, such as claim 13 of the present application, which include only a single element.

Applicant also notes that MPEP §2164.08(a) provides, with emphasis supplied, that “[a] single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. §112, first paragraph.” Again, Applicant notes that claim 13 does not contain any explicit means recitation, and therefore this claim appears to fall outside the literal terms of MPEP §2164.08(a). Moreover, the case law cited in MPEP §2164.08(a) and relied on by the Examiner, namely, In re Hyatt, 218 USPQ 195 (Fed. Cir. 1983), deals with a claim that does include an explicit means recitation. The claim language at issue in that case is as follows, with emphasis supplied:

35. A Fourier transform processor for generating Fourier transformed incremental output signals in response to incremental input signals, said Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals in response to the incremental input signals.

The Federal Circuit in the above-cited In re Hyatt case stated as follows in finding this claim to be a single element means claim in violation of §112, first paragraph:

The final paragraph of §112 saves combination claims drafted using means-plus-function format from this problem by providing a construction of that format narrow enough to avoid the problem of undue breadth as forbidden by the first paragraph. But no provision saves a claim drafted in means-plus-function format which is not drawn to a combination, i.e., a single means claim. In re Hyatt, 218 USPQ at 197, emphasis in original.

The In re Hyatt case and MPEP §2164.08(a) therefore fail to provide adequate support for the present rejection of single element claim 13 which does not include an explicit means recitation. More specifically, Applicant submits that there is insufficient support provided in the Office Action for the stated §112, first paragraph rejection of a single element claim which does not include an explicit means recitation.

Accordingly, although claim 13 includes only a single element, it does not include a means recitation, and Applicant therefore respectfully submits that this claim is not a single element means claim. The rejection under §112, first paragraph, is thus believed to be improper, and should be withdrawn.

Notwithstanding the foregoing traversal, Applicant has amended independent claim 13 so as to recite that the signal processing device comprises an integrated circuit. Support for the amendment can be found in the specification at, for example, page 4, line 27, to page 5, line 2, wherein it is indicated that the claimed signal processing device may comprise, without limitation: a DSP or microprocessor, both typically implemented as integrated circuits; a computer, which

typically includes one or more integrated circuits; an ASIC; or another type of device, such as a filter, encoder or decoder, that is suitable for implementation in the form of an integrated circuit. Applicant submits that, in view of the above traversal, this amendment is made solely for expediting allowance of the application, rather than for a reason relating to the patentability of claim 13 or its associated dependent claims 14-24.

With regard to the §102(b) rejection, Applicant respectfully traverses on the ground that the rejection as set forth in the Office Action is improper due to a lack of clarity. The Examiner at page 3, section 4, first paragraph, of the Office Action indicates that claims 1, 3-6, 8-10, 13, 15-18, 20-22 and 25 are rejected over U.S. Patent No. 5,583,963 (hereinafter "Lozach"). However, the subsequent explanation of the rejection at pages 3-4 of the Office Action apparently relies on passages, not from Lozach, but from another patent, namely U.S. Patent No. 5,018,065 (hereinafter "McWhirter"). Thus, the rejection is improper on its face, and should be withdrawn. Any subsequent Office Action rejecting these claims must be made non-final, as Applicant has not been provided, in the present Office Action, a clear rejection to which an appropriate response on the merits can be made.

Applicant also notes that page 3, section 4, first paragraph, of the Office Action fails to indicate that claims 12 and 24 are rejected under §102(b). Thus, the status of these claims is unclear, which is a further indication of the impropriety of the present §102(b) rejection.

Since the §102(b) rejection of independent claims 1, 13 and 25 is improper, as described above, the dependent claims rejected under §103(a) are also believed to be patentable.

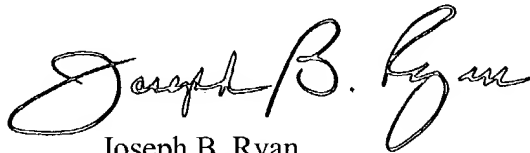
Notwithstanding the foregoing traversal, Applicant has amended independent claims 1, 13 and 25 to clarify the subject matter which Applicant regards as the invention. More specifically, each of the independent claims has been amended to recite that computations associated with transform updating are configured to provide local optimization of an energy compaction property of the transform for a given pair of transform coefficients. Such an arrangement is not taught or suggested by Lozach or McWhirter, alone or in combination. Support for the amendment can be found in the specification at, for example, page 6, lines 19-21, and page 18, line 15, to page 19, line 8. Applicant again submits that, in view of the traversal of the §102(b) and §103(a) rejections, this

amendment is made solely for expediting allowance of the application, rather than for a reason relating to the patentability of the amended claims.

Dependent claims 11 and 23 have been rewritten in independent form, and are believed allowable in view of the indication of allowable subject matter.

In view of the above, Applicant believes that claims 1-25 are in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, reading "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" clearly legible.

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